

**REMARKS**

The present application relates to hybrid maize plant and seed 38T27. Claims 1-42 are currently pending in the present application. Applicant respectfully requests consideration of the following remarks.

**Detailed Action*****A. Specification***

Applicant acknowledges the objection to the specification for the presence of a blank line on page 7 as withdrawn.

***B. Claim Objections***

Applicant acknowledges the objection to claims 6, 12, 16, 25 and 29 as withdrawn. The rejections of claims 1-32 under 35 U.S.C. § 112, second paragraph, is acknowledged as withdrawn in light of the claim amendments. Applicant acknowledges the rejection of claims 1-32 under 35 U.S.C. § 112, first paragraph, requiring a deposit of the maize seed of the invention, as withdrawn in light of the deposit and the deposit statement in the specification and the paper received on November 13, 2002. Finally, Applicant acknowledge the rejections of claims 1-32 under 35 U.S.C. § 102(e)/103(a) as withdrawn.

***C. Deposit Statement***

Applicant submits the Deposit section has been amended in order to properly include both the hybrid maize plant 38T27 and the inbred parents GE533329 and GE501400 within the deposit paragraph on page 46. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The specification has now been amended to correct these minor changes.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 8, 11, 15, 19, 21, 24, 28, 32, 34, and 38-42 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 8, 21, and 41 stand rejected as indefinite for the recitation "genetic factor".

Applicant has now cancelled claims 8, 21, and 41, thus alleviating this rejection.



The Examiner rejects claims 11, 15, 19, 24, 28, and 32 for the recitation "significantly different" as rendering the claims indefinite.

Applicant has now canceled claims 11, 15, 19, 24, 28, and 32, thereby alleviating this rejection.

Claims 11, 15, 19, 24, 28, 32, 38, and 39 were rejected as indefinite for the recitations "has derived at least 50% of its alleles" in claims 11, 15, 19, 24, 28, and 32, and "deriving at least 50% of its alleles" in claims 38 and 39. The Examiner states it is not clear what is meant by "derived" and "deriving".

Applicant has cancelled claims 11, 15, 19, 24, 28, 32, 38 and 39, alleviating this rejection.

The Examiner rejects claim 34 as indefinite for the recitation "essentially" in line 3.

Applicant has cancelled claim 34, thus alleviating this rejection.

Claim 38 stands rejected as indefinite for the recitation "on average, deriving at least 50%" in line 2.

Applicant has cancelled claim 38, thereby alleviating this rejection.

The Examiner rejects claim 39 for the recitation "A 38T27 maize plant selected from the population of 38T27 progeny maize plants" as indefinite.

Applicant has cancelled claim 39, alleviating this rejection.

Claim 40 stands rejected as being indefinite for the recitation "further comprising applying double haploid methods".

Applicant has cancelled claim 40, thus alleviating this rejection.

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

#### Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 9-19 and 22-32 remain rejected and claims 34-40 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office Action mailed August 13, 2002.



The Examiner states that the deposit of seed of plant 38T27 does not provide a description of the plant that is encompassed by the rejected claims, which have not been deposited. The Examiner further states that 50% of the alleles of the claimed plants will be inherited from the other parent, for which no description is provided. The Examiner suggests that claims 12 and 25 be amended by listing the types of transgenes that may be introduced. The Examiner further states the specification does not describe any traits of any inbred plants or any progeny plants produced from 38T27.

Applicant has cancelled claims 9-19, 22-32, and 34-40, thus alleviating this rejection.

Claim 33 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner states the claim is drawn towards a method of making a hybrid plant designed 38T27 comprising crossing inbred maize plants GE533329 and GE501400. Claim 33 recites that the deposit numbers for two inbred maize plants, and page 7 of the specification indicates that these lines have been deposited with the ATCC. However, the Examiner states the terms of this deposit are not known.

Applicant respectfully traverses this rejection. Applicant herein submits the Deposits section has been amended in order to properly include both the hybrid maize plant 38T27 and the inbred parents GE533329 and GE501400 within the deposit paragraph. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The Applicant provides assurance that:

- a) during the pendency of this application access to the invention will be afforded to the Commissioner upon request;
- b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- c) the deposit will be maintained in a public depository for a period of thirty years, or five years after the last request for the enforceable life of the patent, whichever is longer;



- d) a test of the viability of the biological material at the time of deposit will be conducted (see 37 C.F.R. § 1.807); and
- e) the deposit will be replaced if it should ever become inviable.

Therefore, Applicant submits at least 2500 seeds of hybrid maize plant 38T27 and the inbred parents GE533329 and GE501400 have been deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02) Such action is respectfully requested. Applicant thanks the Examiner for pointing out this inadvertent mistake.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration withdrawn of the rejections to claims 9-19 and 22-40 under 35 U.S.C. § 112, first paragraph.

Applicant acknowledges that claims 1-7 and 20 are allowed.

#### Conclusion

In conclusion, Applicants submit in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

No additional fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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